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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,663	06/26/2006	Yun-foo Wu	78829 119-13 US/PCT	5008
27975 7590 01/25/2010 ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A. 1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE P.O. BOX 3791 ORLANDO, FL 32802-3791			EXAMINER LALLI, MELISSA LYNN	
			ART UNIT 3728	PAPER NUMBER
			NOTIFICATION DATE 01/25/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

creganoa@addmg.com

Office Action Summary	Application No. 10/584,663	Applicant(s) WU, YUN-FOO	
	Examiner MELISSA L. LALLI	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/28/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because "ball 212" as stated in paragraph [19], line 11 should read "ball 211". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract

2. The abstract of the disclosure is objected to because it is ungrammatical. More specifically, "This invention can adjust shock attenuation and damping effect, and is practical and reliable, can be suitable for human body's requirements to the utmost

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extent” is confusing. The entire abstract should also be edited for such errors.

Correction is required. See MPEP § 608.01(b).

Specification

3. The disclosure is objected to because of the following informalities: the specification is generally narrative in several areas. Additionally, there are many grammatical and idiomatic errors; hence, the entire specification should be edited for such errors.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 provides for the use of a “pressure controller” for adjustment of pressure in an “elastic insole of shoes”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1 recites the limitation "the pressure controller" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitations "the entry of the flow passage" and "the exit of the flow passage" in line 3. There is insufficient antecedent basis for these limitations in the claim.

Claim 6 recites the limitations "the exterior bottom of the rotation shaft", "the middle part of said rotation shaft", "the first ball valve", "the interior top of the rotation shaft", and "the second ball valve" in line 3, line 4, line 5, lines 5-6, and line 6 respectively. There is insufficient antecedent basis for these limitations in the claim.

Claim 7 recites the limitation "the number of the ball valves" on lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 1 and 3, the respective limitations "a user may choose to open or close either one of the two pressure controlling modes" and "said adjusting device (3) controls the operation of either one of said two pressure controlling means" are indefinite and misleading. Does the adjusting device control both pressure controlling means or does the adjusting device only operate one of the pressure controlling means one at a time? Applicant is required to clarify and amend the claims as necessary.

Regarding claim 3, there appears to be a repetition of elements regarding the "pressure controller" and "adjusting device" limitations as references to such elements are already made in independent claim 1. From the specification and drawings, it appears that there is only one "pressure controller" and one "adjusting device"; hence, applicant must clarify and amend the claim as necessary.

Regarding claim 5, it is unclear why the "ball valve" as stated on line 2 is introduced as "a second ball valve" when it is the only "ball valve" that has been introduced in that sequence of claims. A "first ball valve" is introduced in claim 4; however, claim 5 is not dependent on claim 4. Applicant is required to clarify and amend the claim as necessary.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 (as best understood) is rejected under 35 U.S.C. 102(b) as being anticipated by US 4,995,173 to Spier.

Regarding claim 1, Spier discloses a shock attenuation method of an elastic insole of shoes, wherein a pressure controller in the elastic insole of shoes has at least two pressure controlling modes (fig. 1, valves 14, 26, and 30), and by adjusting with a

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screw element (40), a user may choose to open or close either one of the two pressure controlling modes.

8. Claims 1-5 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,846,063 to Lakic.

Regarding claims 1-5, Lakic discloses a shock attenuation method of an elastic insole of shoes (fig. 50), wherein a pressure controller in the elastic insole of shoes has at least two pressure controlling modes (fig. 50, 64, 70, & 76), and by adjusting with a screw element (fig. 135, 60), a user may choose to open or close either one of the two pressure controlling modes. The insole body (85) has the pressure controller (fig. 135, valve 758 is an alternative to valve 58 shown in fig. 50) located at its side (fig. 50), wherein the pressure controller includes a multi-pipe circulating flow pressure controlling means (figs. 50 & 135, 70 & 76) and a single-pipe bi-directional flow pressure controlling means (figs. 50 & 135, 64), and an adjusting device (60) is further installed between said multi-pipe circulating flow pressure controlling means and said single-pipe bi-directional flow pressure controlling means (figs. 50 & 135), and said adjusting device controls the operation of either one of said two pressure controlling means. The multi-pipe circulating flow pressure controlling means includes a first ball valve (108) as the entry of the flow passage and a vane valve (92) as the exit of the flow passage. The single-pipe bi-directional flow pressure controlling means includes a second ball valve (696) as the access of the flow passage, said second ball valve is equipped with a spring (102).

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9. Claims 1-3 (as best understood) are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,892,477 to Potter et al. (Potter).

Regarding claims 1-3, Potter discloses a shock attenuation method of an elastic insole of shoes (figs. 4-7), wherein a pressure controller in the elastic insole of shoes has at least two pressure controlling modes (fig. 4, 200), and by adjusting with a screw element (524 and/or 526), a user may choose to open or close either one of the two pressure controlling modes. The insole body (11) has the pressure controller located at its side (fig. 4), wherein the pressure controller includes a multi-pipe circulating flow pressure controlling means (514a-f) and a single-pipe bi-directional flow pressure controlling means (519c), and an adjusting device (200) is further installed between said multi-pipe circulating flow pressure controlling means and said single-pipe bi-directional flow pressure controlling means (fig. 4), and said adjusting device controls the operation of either one of said two pressure controlling means.

10. Claim 1 (as best understood) is rejected under 35 U.S.C. 102(b) as being anticipated by US 4,446,634 to Johnson et al. (Johnson).

Regarding claim 1, Johnson discloses a shock attenuation method of an elastic insole of shoes, wherein a pressure controller in the elastic insole of shoes has at least two pressure controlling modes (fig. 4, 26 & 34), and by adjusting with a screw element (30 and/or 38), a user may choose to open or close either one of the two pressure controlling modes.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6 and 7 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakic.

Regarding claims 6 and 7, Lakic discloses the adjusting device (60) including a rotation shaft (fig. 135, unlabeled rotation shaft), an adjusting turn button (fig. 135, see unlabeled head of adjusting device 60) connected to an exterior bottom of the rotation shaft, and an adjusting tip (fig. 135, see unlabeled tip of adjusting device 60) is set on the interior top of the rotation shaft so as to press against a ball (98) of a second ball valve and make the ball displace longitudinally (fig. 135). Lakic does not explicitly disclose disc-shaped adjusting heads sleeved on a middle part of the rotation shaft to laterally displace a ball (696) of a first ball valve; however, Official Notice is taken that it is old and conventional in the art to use disc-shaped adjusting heads in combination with ball valves in order to facilitate control and adjustment of a valve. It would have been obvious to one having ordinary skill in the art at the time of the invention in view of the Official Notice to have incorporated/substituted disc-shaped adjusting heads in the pressure controller of Lakic for precise adjustment of the pressure controller as such structures are well known in art and as a matter of obvious design choice. The claim would have been obvious because the substitution of one known element for another

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would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Furthermore, it is well known in the art that the number of disc-shaped adjusting heads corresponds to the number of ball valves to be controlled.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Demon and Shiang have been included because they are relevant to the claimed subject matter.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA L. LALLI whose telephone number is (571)270-5056. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLL
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/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728